

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JED E. ROSE, FREDERIQUE M. BEHM, JUSTIN P. ROSE,
ANDREW M. ROSE, and ANTHONY E. ROSE

Appeal 2006-3079
Application 10/708,033
Technology Center 3700

Decided: May 30, 2007

Before TERRY J. OWENS, JENNIFER D. BAHR, and LINDA E.
HORNER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jed E. Rose et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-27. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Appellants' claimed invention is directed to a card game. The card game utilizes a deck of cards divided into a first suit, consisting of threat cards, and second suit, consisting of tool cards, and involves players selecting a hand including a card from the first suit and at least one card from the second suit, telling a story based on the selected hand of cards, and receiving scores from the other players. (Specification [0004] – [0005].)

Claims 1 and 12 are illustrative of the invention and read as follows:

1. Playing cards comprising a deck divided into a first suit and a second suit, wherein the first suit comprises threat cards, and the second suit comprises tool cards.

12. A method of playing a card game comprising:

(a) providing playing cards comprising a deck having a first suit and a second suit, wherein the first suit comprises threat cards, and the second suit comprises tool cards, and wherein the first suit and the second suit are separated from each other into a first group and a second group;

(b) a first player selecting a threat card from the first group and a tool card from the second group, and telling a story based on the selected hand of cards, and scoring from zero points to a selected number of points for the story;

(c) continuing play as in step (b) with at least one other player; and

(d) continuing with play among players until all cards have been selected from the two groups or until an agreed upon time has been reached.

The Examiner relies upon the following as evidence of unpatentability:

Bouchal	US 4,637,799	Jan. 20, 1987
Dwyer	US 5,417,432	May 23, 1995

Calhoun

US 5,547,199

Aug. 20, 1996

Appellants seek review of the Examiner's rejections of claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by Dwyer and claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Bouchal. The rejection of claims 1-11 under 35 U.S.C. § 101 has been withdrawn (Answer 3).

The Examiner provides reasoning in support of the rejections in the Answer (mailed March 14, 2006). Appellants present opposing arguments in the Appeal Brief (filed November 17, 2005) and Reply Brief (filed May 15, 2006).

THE ISSUES

Appellants contend that claims 1 and 11 are not anticipated by Dwyer because Dwyer's alphabet playing card deck does not comprise two suits (Appeal Br. 6-8 and 14-17). Appellants additionally contend that dependent claims 2-10 are not anticipated by Dwyer because the particular features recited in these claims are not disclosed by Dwyer (Appeal Br. 9-12). With respect to the rejection of claims 12-27 as unpatentable over Calhoun in view of Bouchal, Appellants contend the Examiner has impermissibly ignored teachings of Calhoun directed to a predetermined, inherent relationship of the sentence and picture cards of Calhoun to one another (Appeal Br. 19, 25). Appellants further contend the features recited in dependent claims 13-26 are not taught or suggested by Calhoun and Bouchal, alone or in combination (Appeal Br. 21-25).

In light of Appellants' contentions, the first issue before us is whether Appellants have demonstrated that the Examiner erred in rejecting any of

claims 1-11 as anticipated by Dwyer and, more specifically, that Dwyer lacks a deck comprising two suits, as recited in claims 1 and 11, or that any of the features recited in dependent claims 2-10 patentably distinguishes over Dwyer. The second issue is whether Appellants have demonstrated either that Calhoun discloses a predetermined, inherent relationship between the sentence and picture cards that so departs from the subject matter of claims 12-27 that claims 12-27 are patentable over Calhoun in view of Bouchal or that any of the features recited in dependent claims 13-26 patentably distinguishes over Calhoun in view of Bouchal.

FINDINGS OF FACT (FF)

FF1. Dwyer discloses an alphabet playing card deck comprising 52 cards consisting of two duplicate sets of alphabetic cards and an additional four cards including “wild or joker” cards or informational cards (Dwyer, col. 6, ll. 20-23). Each letter card may also include additional smaller representations of the letter in the upper right and lower left hand corners (Dwyer, col. 6, ll. 28-31). Each of the sets of alphabetic cards has 26 cards (Dwyer, Abstract).

FF2. As illustrated in Figs. 5A-C, each card preferably also depicts a subject, the spelling of which starts with the same alphabetic letter appearing on the face of that card (Dwyer, col. 6, ll. 44-47).

FF3. Dwyer discloses “different colored borders or other differentiating feature for each of the two sets of alphabetic cards” to permit young children to separate the card deck into two complete alphabetic sequences (Dwyer, col. 8, ll. 51-55).

FF4. The ordinary and customary usage of the term “suit” within the context of playing cards is “a group of similar things forming a set or series; specific., any of the four sets of thirteen playing cards each (spades, clubs, hearts, and diamonds) that together make up a pack” (*Webster's New World Dictionary* 1424 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984)).

FF5. Calhoun discloses a card game utilizing cards including sentence cards 10, picture cards 14, and thumbs-up and thumbs-down scoring cards 30, 33 (Calhoun, col. 3, ll. 32-41). In playing the game, each player receives one sentence card 10, a plurality of picture cards 14, a sentence guide or display means 17, one thumbs-up card 30, and one thumbs-down card 33. Each sentence card 10 has a plurality of sentences 12 thereon, with corresponding value indicia 13 for each sentence. Each picture card 14 has a plurality of pictorial elements 16 thereon. Essentially, players can discard and receive additional picture cards 14 until one player is ready to attempt to form a chosen sentence 12 by relating the pictorial elements 16 on the picture cards 14 to words in the chosen sentence 12 “in an interesting, creative, and/or entertaining way.” (Calhoun, col. 5, l. 54 to col. 6, l. 26.) The player explains to the opposing players how the pictorial elements 16 on the picture cards 14 relate to the words that make up the chosen sentence 12 on the sentence card 10 (Calhoun, col. 6, ll. 33-37).

The explanation must show to the other players interesting, creative, and/or entertaining relationships between the picture elements 16 and the words that make up the chosen sentence 12 on sentence card or sentence means 10. These relationships can be based on rhymes, definitions,

letters, synonyms, antonyms, metaphors, or of any other type.

(Calhoun, col. 6, ll. 37-43.)

FF6. The opposing players then indicate whether, in their judgment, the player who formed the chosen sentence did so “in an interesting, creative, and/or entertaining way” by using the thumbs-up or thumbs-down card. If a majority of the opposing players display a thumbs-up card to indicate a favorable response, the player who formed the chosen sentence scores the number of points indicated by the value indicia for the chosen sentence.

(Calhoun, col. 7, ll. 25-36.) In an alternate embodiment, rating cards or scoring means 27 may be used in lieu of the thumbs-up and thumbs-down cards (Calhoun, col. 8, ll. 17-24).

FF7. Calhoun gives examples of relationships between the sentences 12 on the sentence card 10 illustrated in Fig. 1 and the pictures 16 on the picture card 14 (Calhoun, col. 6, l. 50 to col. 7, l. 24). One such relationship between King Neptune 16a on the picture card 14 and the word “King” or the word “God” in sentence 12a on sentence card 10 is that “King Neptune was both King of the sea as well as a God in mythology” (Calhoun, col. 6, ll. 50-55).

FF8. The ordinary and customary meaning of “story” is “the telling of a happening or connected series of happenings, whether true or fictitious” (*Webster's New World Dictionary* 1405 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984)). The types of relationships described by Calhoun (FF7) are stories, as that term is ordinarily and customarily used.

FF9. Appellants' Specification does not define "story" or indicate in any manner a use of the term "story" that differs from the ordinary and customary definition (FF8).

FF10. Calhoun discloses an embodiment of the game in which a timing device or timing means 26 is used to place a time restriction on a player's explanation. In such an embodiment, players must explain the relationships within a limited amount of time. (Calhoun, col. 8, ll. 30-38.)

FF11. Bouchal evidences that educational card games in which a child or other subject selects cards from a deck of cards bearing visual presentations of a situation and uses those cards to tell a story were known at the time of Appellants' invention. From those cards, the child or other subject uses some or all of the cards in the set to create a story, which story may be as long and involved as the child or other subject chooses. (Bouchal, col. 2, ll. 3-22.)

DISCUSSION

We begin our analysis with the rejection of claim 1 as anticipated by Dwyer. To establish anticipation, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Anticipation does not require that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly-Clark*

Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). The only element of claims 1 and 11 identified by Appellants as lacking in Dwyer is the deck being divided into a first “suit” and a second “suit.” According to Appellants, the two sets of alphabetic cards in Dwyer’s deck are of the same suit, because the only difference between the two sets is the color of the border design. (Appeal Br. 7) This position is not well taken.

We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). Appellants’ Specification gives no hint that the term “suit” is used in any manner other than the ordinary and customary usage of this term (FF4) and, further, in characterizing the threat and tool cards as being of two different suits (Specification [0005]), clearly indicates that the term “suit” is not limited to the more specific definition, that is, spades, clubs, hearts, and diamonds, but rather, is sufficiently broad to encompass any group of cards forming a set or series.

Appellants concede that Dwyer’s deck includes two suits, but characterizes the cards of the first suit as being “the same as the cards of the second suit, with only a minor variance in border color” (Appeal Br. 8). Appellants’ characterization of the border color variance as “minor” is not supported by Dwyer. Moreover, Dwyer cites different colored borders as merely one example of a “differentiating feature” to distinguish the cards to permit them to be separated into two complete alphabetic sequences (FF3).

Significantly, Dwyer describes the “differentiating feature,” in whatever form it may take, as differentiating the cards of one set from the cards of the other set. Further, each set forms a complete alphabetic sequence (FF3). As such, each set of cards conforms to the ordinary and customary usage of the term “suit” within the context of playing cards, namely, “a group of similar things forming a set or series.”

We therefore conclude that Appellants have failed to demonstrate the Examiner erred in rejecting claims 1 and 11 as anticipated by Dwyer. The rejection is sustained.

Appellants’ contention that the additional features recited in claims 2 and 3 are not disclosed by Dwyer (Appeal Br. 9 and 12) likewise is unsound. Specifically, each of the sets of alphabetic cards has 26 cards, the second suit thus having the same number of cards as the first suit. Appellants have failed to demonstrate the Examiner erred in rejecting claims 2 and 3 as anticipated by Dwyer. The rejection of claims 2 and 3 is sustained.

The only difference between the subject matter of claims 4-10 and Dwyer resides in the indicia printed on the cards. Where the only difference between the claimed subject matter and the prior art resides in printed matter and the printed matter recited in the claim is not functionally related to the substrate on which it is printed, the printed matter does not distinguish the subject matter of the claim from the prior art in terms of patentability and rejection of the claim under 35 U.S.C. § 102 as anticipated by the prior art is appropriate. *In re Ngai*, 367 F.3d 1336, 1338-39, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

We find that, in Appellants’ invention, the legends and pictures printed on the playing cards are not functionally related to the substrate, that

is, the cards. Appellants' playing cards will function as playing cards regardless of the particular indicia printed thereon. In this respect, the case before us is distinguishable from the situation in *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983), wherein the claimed invention was an educational and recreational mathematical device comprising "three key elements: (1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed." *Id.*, 703 F.2d at 1382, 217 USPQ at 402. The *Gulack* court found that the digits, the printed matter in that case, were related to the band in two ways: "(1) the band supports the digits; and (2) there is an endless sequence of digits — each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band." *Id.*, 703 F.2d at 1386-87, 217 USPQ at 405. There is no such interrelationship between Appellants' cards and the legends and pictures printed thereon. The legends and pictures do not exploit any characteristic of the playing cards on which they are printed but, rather, merely convey an instruction to the player as to the elements required in the story to be told.

We therefore conclude that the legends and pictures recited in Appellants' claims 4-10 do not patentably distinguish the subject matter of the claims from the alphabet playing card deck of Dwyer. The claimed legends and pictures being the only argued distinction between the subject matter of claims 4-10 and Dwyer, aside from the first and second suit limitation, which Dwyer's two sets satisfy, as discussed above, Appellants have failed to demonstrate error in the Examiner's rejection of claims 4-10 as anticipated by Dwyer. The rejection is sustained.

We turn now to the rejection of claims 12-27 as unpatentable over Calhoun in view of Bouchal. Appellants' arguments contesting this rejection focus on what Appellants characterize as an "already predetermined" inherent relationship between the sentence on the sentence card and the pictures on the picture cards (Appeal Br. 19). Given Calhoun's repeated use of the language "interesting, creative, and/or entertaining" (FF5, FF6) to describe the required explanation of the relationships, Appellants' characterization of the relationships as being "already predetermined" and "inherent" strikes us as somewhat unfair. In any event, as pointed out by the Examiner (Answer 8), Appellants' claims 12-27 do not exclude already predetermined, inherent relationships between the legends and pictures on the threat cards and the legends and pictures on the tool cards. In fact, following Appellants' characterization of the relationship of the sentence on the sentence card and the pictures on the picture cards of Calhoun, the legends and pictures on Appellants' threat cards and tool cards may likewise be characterized as already predetermined and inherent, in that they are connected by the story told by the player. We therefore conclude that Appellants' characterization of the relationship between the sentence on the sentence card and the pictures on the picture cards does not demonstrate a patentable distinction between the subject matter of claims 12-27 and Calhoun.

The explanation of the types of relationships described by Calhoun (FF7), especially in light of Calhoun's description of them as "interesting, creative, and/or entertaining" (FF5, FF6), satisfies the limitation of "telling a story based on the selected hand of cards" recited in Appellants' claims 12 and 27 (FF8 and FF9). Accordingly, the rejection of claims 12 and 27 as

unpatentable over Calhoun in view of Bouchal is sustainable on the basis of Calhoun alone.¹ Bouchal, relied on by the Examiner (Answer 5-6) as evidence that it was known in card games at the time of Appellants' invention to observe the legends and pictures on displayed cards and use those legends and pictures to tell a story (*see* FF11), is superfluous.

Claims 25 and 26 additionally recite steps of telling a story within a selected amount of time and providing a time keeper, respectively. Calhoun teaches such (FF10).

The additional limitations recited in dependent claims 13 and 17-22 are directed to printed matter that is not functionally related to the playing cards, as discussed above, and, thus, do not patentably distinguish the claimed subject matter from Calhoun. *See Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864.

Appellants point out additional limitations recited in claims 14-16, 23, and 24² allegedly not taught or suggested by Calhoun and Bouchal, either alone or in combination (Appeal Br. 21-22, 24, and 25) but do not specifically argue why these limitations patentably distinguish the claimed subject matter from Calhoun. "The mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." Where the gap between the prior art and Appellants'

¹ In affirming a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on fewer than all of the references relied on by the Examiner in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1966).

² "A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." 37 C.F.R. § 41.37(c)(1)(vii) (2006).

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claimed invention is not so great as to render the claimed invention nonobvious to one reasonably skilled in the art, the claimed invention is not patentable over the prior art. *Dann v. Johnston*, 425 US 219, 229-30, 189 USPQ 257, 261 (1976).

In light of the above, Appellants have not demonstrated that the Examiner erred in rejecting claims 12-27 as unpatentable over Calhoun in view of Bouchal. The rejection is sustained.

SUMMARY

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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MOORE & VAN ALLEN PLLC
P.O. BOX 13706
Research Triangle Park, NC 27709